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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/944,212

Filing Date: August 31, 2001

Appellant(s): KURTH ET AL.

Aaron J. Wong
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7-16-10 appealing from the Office action
mailed 2-18-10.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 83-108 are pending and rejected.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. All rejections under 35 USC 112 1st paragraph are withdrawn.

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

5,688,860	CROFT	11-1997
4,185,146	BURKE	1-1980
4,720,571	TROWELL	1-1988

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 83-108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Croft (5,688,860) in view of Burke(4,185,146) and Trowell (4,720,571).

Croft discloses polymer materials comprising the reaction product of isocyanates, isocyanate reactive materials, catalysts, extenders/crosslinkers, and other materials of appellants' claims (see column 3 line 53 et seq. & column 10 line 60 – column 12 line 40, as well as, the entire document). Difference based on the ranges of A-side to B-side ratios {isocyanate Index values} is not seen.

Croft differs from appellants' claims in that it does not employ blown vegetable oils in its preparation. However, Burke (see column 1 lines 26-33, as well as, the entire document) discloses blown vegetable oils, including soya oil, to be well known materials used in urethane applications for purposes of providing acceptable reactant materials in forming urethane products. Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the blown vegetable oils as isocyanate reactant materials in the preparations of Croft for the purpose of providing acceptable, natural, reactant materials in the reactive mixture in order to arrive at the products of appellants' claims with the expectation of success in the absence of a showing of new or unexpected results. As to the employed amounts of this respective component, it has long been held that where the general conditions of the claims are disclosed in the prior art, discovering the optimal or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233; *In re Reese* 129 USPQ 402. Similarly, it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272,205 USPQ 215 (CCPA 1980). One looking employ

a more environmentally friendly and less petroleum dependent reactive mix in balance with the other benefits of petroleum based polyols would towards variations in the amounts of respective components with the expectation of success in the absence of a showing of new or unexpected results that are attributable to differences in the claims and commensurate in scope with the scope of the claims. Further, selection of any known transesterification catalyst for purposes of providing transesterification would have been within the purview of the ordinary practitioner in the art in the absence of a showing of new or unexpected results that are demonstrated to be associated with the particular selection identified by the claim(s).

The teachings of Croft in view of Burke differ from appellants' claims in that they do not disclose employment of transesterification/esterification catalysts. However, Trowell (column 3 lines 54-57, as well as, the entire document) discloses the employment of transesterification/esterification catalysts to be well known to the polyurethane foam forming art for their effect of converting ester group containing materials to into isocyanate reactant materials. Accordingly, it would have been obvious for one having ordinary skill in the art to have employed transesterification catalysts disclosed by Trowell in the preparations arriving from the combined teachings of Croft and Burke for the purpose of modifying the reactivities of the reactant materials and enabling enhanced properties in order to arrive at the products of appellants' claims with the expectation of success in the absence of a showing of new or unexpected results.

(10) Response to Argument

Appellants' arguments have been considered. However, rejection is maintained.

Rejection over the combination of teachings is maintained to be evident.

In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

It is Burke that is looked to in order to address the deficiencies of Croft pertaining to the use of blown oils as isocyanate reactant materials, and Trowell (column 3 lines 54-57, as well as, the entire document) is looked to for the employment of transesterification/esterification catalysts in the polyurethane foam forming art for their effect of converting ester group containing materials to into isocyanate reactant materials. One looking to increase isocyanate reactive functionality for benefits including increased crosslink density of products ultimately formed would look to these teachings in combination with the teachings of Croft in order to arrive at the invention of appellants' claims. Examiner, is not merely showing that each element is independently known. Examiner holds that a motivation to combine has been established, and that motivation is sufficient to support the position of obviousness.

As to appellants' arguments regarding the plasticizer of Croft, it is held that the plasticizer of Croft is an additional additive/auxiliary component which is not excluded by the limitations of appellants' claims. The rejection set forth above has been modified to

remove this extraneous mention of the plasticizers of Croft since plasticizers are not a recited feature in any of appellants' claims. However, it remains evident that Croft's additional inclusion of plasticizers, including vegetable oil plasticizers, does not serve to nullify the instant rejection because appellants' claims do not exclude the inclusion of these additional materials of Croft.

The blown vegetable oils of the secondary teaching are not being employed as a plasticizer. It is being employed as an acceptable isocyanate reactive material to be used in the preparations of Croft for its renewable reactant effect. The evidence is clear that upon being functionalized through blowing, blown vegetable oil is no longer a plasticizer. Blown vegetable oil through the action of being functionalized through blowing is an isocyanate reactive material. It is not seen or agreed that the disclosure of Croft at column 3 lines 38-40 supports appellants' position that the modification being proposed would render the prior art invention being modified unsatisfactory for its intended purpose. Examiner's position of obvious is not proposing a modification of the plasticizer of Croft. Examiner's position of obviousness is proposing a modification to the isocyanate reactive component. The plasticizer of Croft is not being modified, and it is maintained that appellants' claims do not exclude the additional inclusion of the plasticizers of Croft.

Appellants' arguments as to the ranges of amount values of their claims have been considered. However, it is maintained that the variables of concern have been established to be result effective variables and it would be obvious to discover optimum or workable ranges by routine experimentation. This holding is seen to be an

appropriate position in the instant case rather than a formal exercise of squeezing new factual situations into pre-established pigeonholes. Additionally, in regards to appellants' arguments on this point, it is seen that the number of references cited in examiner's position of obviousness does not impact the sustainability of the position in this regard.

As to appellants' arguments made in footnote 3 on page 22 of the appeal brief, it is held that appellants' submitted declaration is insufficient in negating the rejection above. Setting forth experiments run and arguments made referring to the results of experiments run that are in apparent contradiction with what is taught by the examples of the cited disclosure are insufficient in negating the instant rejection under 35 USC 103. Further, appellants' tests do not include variations and adaptations from the reference disclosure which any competent worker in the art would be expected to make in order to make the reference disclosure operative. Additionally, appellants' narrow demonstration of the inoperability of a specific embodiment of the referenced Barthel, Jr.'s teaching from Burke does not negate what is disclosed by its fully considered disclosure. Accordingly, rejection is maintained to be proper as set forth above. Appellants' arguments as to the operability of the reference are unpersuasive, it is held and maintained that the disclosure of Barthel, Jr. is enabled in accordance with the requirements of MPEP 2121. Further, it should be noted that MPEP 2121 at its outset states that prior art is presumed to be operable/enabling, and appellants' have not presented evidence that sufficiently demonstrates inoperability of Barthel, Jr. in a way that meets the requirements of MPEP 716.07.

As to the language of the claims pertaining to the make-up of the polyol and blown vegetable oils of the instant invention, it is seen that this descriptive language is directed towards features that are intrinsic to the make-up of these components, and difference in a patentable sense based on this inserted language is not seen. Similarly, the language in claim 84 is seen to be describing the transesterification reaction that occurs in forming the products claimed, and difference over what is taught or fairly suggested by the teachings of the combinations of the prior art is not seen to be evident.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

John M. Cooney, Jr.

/John Cooney/

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Conferees:

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